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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/294,461	04/19/99	ADAMS	5012-3653

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EXAMINER
THOMPSON JR, F

ART UNIT	PAPER NUMBER
2765	

DATE MAILED: 07/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/294,461

Applicant(s)
ADAMS et al.

Examiner
Forest Thompson Jr.

Group Art Unit
2765



☒ Responsive to communication(s) filed on Apr 19, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-13 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-13 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Claims 1-13 have been examined.

Drawings

2. The drawings filed on 04/19/99 are acceptable subject to correction of the informalities indicated on the attached "Notice of Draftsperson's Patent Drawing Review," PTO-948.

Correction is required.

Specification

3. The abstract is too long. See 37 CFR 1.72. The language and content of the abstract should conform to the requirements stated in the Manual of Patent Examining Procedure, section 608.01(b), Language and Format:

The abstract should be in narrative form and generally **limited to a single paragraph within the range of 50 to 250 words. The abstract should not exceed 25 lines of text.**

Abstracts exceeding 25 lines of text should be checked to see that it does not exceed 250 words in length since the space provided for the abstract on the computer tape by the printer is limited.

If the abstract cannot be placed on the computer tape because of its excessive length, the application will be returned to the examiner for preparation of a shorter abstract. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided.

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The abstract should sufficiently describe the disclosure to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "This disclosure concerns," "The disclosure defined by this invention," "This disclosure describes," etc.

The abstract exceeds 25 lines and 250 words in length. The applicant must modify the abstract to conform to the above stated requirements.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitations: (a) at pg. 64, "one or more consumer units" on line 2, "the one or more consumer units" on lines 10-11, "the at least one consumer unit" on line 18, "the consumer unit" on line 19, "the consumer unit" on line 20, and "the consumer unit" on line 24; and at pg. 65, "the consumer unit" on line 1 and "the consumer unit" on line 7. There is insufficient antecedent basis for these limitations in the claim.

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Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 1-2, 4-6, and 12 are rejected under 35 U.S.C. 102(e) as being anticipated by **Gregory** (U.S. Patent No. 5,909,673).

As per claim 1, **Gregory** discloses:

- one or more consumer units operated by a consumer (fig. 1; col. 6 lines 23-30; col. 22 lines 40-50);
- communications means connectable over a communication medium to at least a coupon server (col. 6 lines 23-30; col. 8 lines 4-20);
- a user input device to permit a consumer to make one or more choices displayed on the display monitor (6 lines 23-30; col. 7 lines 65-67; col. 8 lines 1-10);
- a coupon server located remotely from the one or more consumer units (col. 3 lines 52-59; col. 6 lines 54-55) comprising:
 - a memory for storing:

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--- first data corresponding to one or more participating retail outlets including data for identifying each of the retail outlets by name and inventory of goods offered for sale (col. 6 lines 54-64; col. 7 lines 1-31);

--- second data containing coupon data used for generating electronic discount coupons for selected goods (col. 7 lines 20-31);

-- a data processing unit having communication means connectable over the communication medium to the at least one consumer unit (col. 8 lines 2-7);

-- first means responsive to a connection with a consumer unit to transmit for display on the display monitor of the consumer unit a first rule containing a list of participating retail outlets which may be individually selected by the consumer using the user input device (col. 3 lines 57-67);

-- second means responsive to the selection of a retail outlet by the consumer to transmit to the consumer unit a second file containing first data corresponding to the selected retail outlet for display on the display monitor of the consumer unit, the second file containing the identity of goods offered for sale by the selected retail outlet, and the displayed goods being individually selected by the consumer using the user input device (col. 3 lines 57-67); and

-- third means responsive to the selection of one or more items of goods by the consumer to transmit a third file for display on the display monitor of the consumer unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods (col. 3 lines 57-67).

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As per claim 2, **Gregory** discloses:

- means for acquiring identifying indicia for identifying the geographical location of a consumer unit connected thereto (col. 6 lines 23-28; col. 6 lines 54-64; col. 7 lines 1-31);
- selecting one or more participating retail outlets in the vicinity of the consumer unit (col. 7 lines 1-31); and
- downloading for display on the display monitor of the consumer unit the first file containing a list of the selected retail outlets (col. 7 lines 20-31).

As per claim 4, **Gregory** discloses means for transmitting a file to the consumer unit containing a form (col. 7 lines 20-29).

As per claim 5, **Gregory** discloses a hardcopy apparatus for producing a hardcopy of electronic coupons transmitted to the consumer unit (col. 7 lines 24-29).

As per claim 6, **Gregory** discloses a printer connected to a consumer unit (col. 8 lines 21-29).

As per claim 12, **Gregory** discloses one or more consumer units comprise client computers on a network (col. 6 lines 23-28).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregory** (U.S. Patent No. 5,909,673), and further in view of **Katz et al.** (U.S. Patent No. 6,055,513).

As per claim 3, **Gregory** discloses the communication medium comprises a public telephone network (col. 8 lines 2-7). **Gregory** does not disclose means for acquiring caller ID data to identify the geographical location of the consumer unit. However, **Katz et al.** disclose:

- the communication medium comprises a public telephone network (col. 15 lines 38-65), and
- means for acquiring caller ID data to identify the geographical location of the consumer unit (col. 16 lines 9-17).

Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Gregory** and **Katz et al.** to disclose the communication medium comprises a public telephone network and means for acquiring caller ID data to identify the geographical location of the consumer unit, because this capability provides obvious and useful enhancements to the invention for the expeditious identification of callers.

10. Claims 7-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregory** (U.S. Patent No. 5,909,673).

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As per claim 7, **Gregory** discloses:

- a point-of-sale unit located in a participating retail outlet (col. 6 lines 23-28), as described in col. 6 lines 23-29 and col. 22 lines 33-50 as a computer and associated components; and
- a hardcopy apparatus (col. 6 lines 28-30).

Official Notice is taken that it was old and well known in the art at the time the invention was made that a computer typically is comprised of a display monitor, a memory for storing data to be displayed on the display monitor, a data processing unit; a hardcopy apparatus, and a user input device. Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Gregory** and old and well known art to disclose a point of sale unit comprising a hardcopy apparatus, a display monitor, a memory for storing data to be displayed on the display monitor, a data processing unit, a hardcopy apparatus, and a user input device, because this configuration provides functionality that is necessary for the invention to operate.

As per claim 8, **Gregory** discloses:

- the coupon server is located remotely from the point-of-sale unit (col. 6 lines 23-28), and further comprises:

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-- fourth means for transmitting to the point-of-sale unit a fourth file containing the identity of goods offered for sale by the retail outlet at which the point-of-sale unit is located (col. 6 lines 54-61);

-- the third means of the coupon server is responsive to the selection of one or more items of goods by the consumer to transmit the third file for display on the display monitor of the point-of-sale unit containing second data corresponding to the selected goods, the third file containing electronic coupons corresponding to one or more of the selected goods (col. 22 lines 8-24).

11. Claims 9, 10, and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregory** (U.S. Patent No. 5,909,673), and further in view of **Burke** (U.S. Patent No. 5,848,399).

As per claims 9, 10 and 11, **Gregory** does not disclose data representative of the physical layout of the participating retail outlets indicating the location of the goods offered for sale, fifth means responsive to the selection of one or more items of goods by the consumer to transmit a fifth file for display on the display monitor of the consumer unit containing data identifying the location in the selected retail outlet of the goods selected by the consumer, nor the second file contains graphical data for displaying a representation of the physical layout of the goods in the selected retail outlet. However, **Burke** discloses *an output of the retail space management system 52 is a three-dimensional description 56 of the store space, including product descriptions (UPC information), shelf and product sizes and locations in three spatial*

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*dimensions, and product category locations, preferably in Cartesian coordinates. Typically, the description 56 includes a floor plan which indicates the location and sizes of each product category within the store. A file is also generated for each product category, indicating the product and shelf sizes and locations for the product category. This description 56 can be stored in a store database 61, accessible by an indication of the store 59 which it describes (col. 4 lines 58-67; col. 5 lines 1-25). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Gregory** and **Burke** to disclose data representative of the physical layout of the participating retail outlets indicating the location of the goods offered for sale, fifth means responsive to the selection of one or more items of goods by the consumer to transmit a fifth file for display on the display monitor of the consumer unit containing data identifying the location in the selected retail outlet of the goods selected by the consumer, and the second file contains graphical data for displaying a representation of the physical layout of the goods in the selected retail outlet, because this would allow the users or customers to more easily locate the specific items or goods that they want to purchase and will enhance customer attraction to the merchant.*

12. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over **Gregory** (U.S. Patent No. 5,909,673), and further in view of **Jovicic et al.** (U.S. Patent No. 5,855,007).

As per claim 13, **Gregory** does not disclose the coupon server comprises an Internet host computer. However, **Jovicic et al.** discloses an electronic coupon communication system for

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generating and redeeming unique product discount coupons over public computer networks such as the Internet. The system comprises a first Internet node, an Internet coupon server and an Internet coupon notification center (Abstract). Therefore, it would have been obvious to one skilled in the art at the time the invention was made to combine **Gregory and Jovicic et al.** to disclose the coupon server comprises an Internet host computer, because this would provide the capability for easy and wide area connectivity to users.

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

- **DeLapa et al.** (U.S. Patent No. 6,076,068) disclose a computer-implemented method and apparatus for generating coupons to provide discounts for purchases which include providing a computer-based kiosk at a retail establishment such as a grocery store.
- **Perkowski** (U.S. Patent No. 6,064,979) discloses a method of and system for finding and serving consumer product-related information on the Internet comprising a database serving subsystem which stores product data.
- **Scroggie et al.** (U.S. Patent No. 6,014,634) disclose a system and method for delivering purchasing incentives and a variety of other retail shopping aids through a computer network, such as E-mail over the Internet or the World Wide Web.

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- **Shilcrat** (U.S. Patent No. 5,963,948) discloses an item locating and path generating computer system which creates personalized paths through structures.
- **Smolen** (U.S. Patent No. 5,915,243) discloses a method and apparatus for offering promotions to a consumer on the basis of a dynamic information profile formed by creating an initial information profile for the consumer.
- **Burke** (U.S. Patent No. 5,848,399) discloses a system for generating images representative of a store shelf which includes a retail space management system for generating information describing product and shelf sizes and locations in three dimensions, and including a code which is unique to each product.
- **Larson et al.** (U.S. Patent No. 5,708,782) disclose an apparatus, software and method for selecting, printing, and dispensing a redeemable discount coupon and other offerings in response to the taking of or upon the return of a cart to an electronic coupon dispensing terminal.
- **Lockwood et al.** (U.S. Patent No. 4,359,631) disclose a self service terminal for dispensing voice and video information, printed documents, and goods; and for accepting service orders and payments therefor by currency or credit card.

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Forest Thompson whose telephone number is (703) 306-5449. The examiner can normally be reached Monday-Friday from 7:30 AM to 4:00 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

June 21, 2000 /FOT



ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER